

REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and this paper is in response thereto.

Applicants have added new claims 12-17 that reflect the Examiner's suggestions offered during a telephone interview. The newly added claims include "a bidirectional interface unit remote from said fitting calculator" as claimed in independent claims 12 and 17. In contrast, the references cited in the Office action teach interfaces at the fitting calculator unit. Accordingly, the combination of references fails to teach every feature of the present invention.

Claims 6, 8, and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over applicants admitted prior art (APA) of figure 1. For the following reasons, the rejection is respectfully traversed.

Claim 6 recites a fitting system wherein "said output of said rating unit being linked to said input of said fitting calculator unit and said setting signal output of said calculator unit being linkable to said setting input of said hearing device at said individual via a bidirectional interface unit" (lines 8-11). Claim 11 recites similar limitations at lines 10-14.

The prior art of figure 1 discloses a unidirectional interface 5 connecting the hearing aid 7 with the digital computer 3 so that the computer 3 can send a signal to the hearing aid 7. Further, figure 1 shows a unidirectional interface 11 connecting the computer 3 with the rating unit 9, so that the rating unit 9 can send a signal to the computer 3 (see also specification page 3, first paragraph).

The Examiner admits that the APA does not show the bidirectional interface as recited in the claim language, but states that because bi-directional communication with a computer and an external device is known, that providing a bi-directional interface to the APA would be "obvious".

The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion or motivation* to modify the reference (MPEP §2143.01). The mere fact that

references *can* be combined or modified is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*).

The Examiner has cited no reference to support the suggested modification of adding a bidirectional interface to the APA. Instead, the Examiner has merely relied on the fact that bidirectional interfaces are known in the computer field. However, no *motivation* has been provided to support a bi-directional interface being added to the APA. Such motivation *cannot* be found in the application itself, as such hindsight reconstruction is impermissible; the facts *must* be gleaned from the prior art. (MPEP §2142, last paragraph).

Clearly, the Examiner cannot merely rely on the known existence of bidirectional interfaces without some *motivation*, found *outside* of the application, to add the feature to the APA. However, the Examiner has provided no such prior art, and has instead relied solely and improperly on the application itself for the requisite motivation. A general statement that bi-directional interfaces provide easy, fast communication is not sufficient to support a *prima facie* case of obviousness; many different types of interfaces can be easy and fast. Merely listing an advantage or benefit is not sufficient motivation (MPEP §2144). Examiner must provide motivation from the prior art supporting the application of a bi-directional interface to the APA, not merely find generalized use of bidirectional interfaces. Consequently, the Examiner has failed to support a *prima facie* case of obviousness, and thus claims 6 and 11 are patentable over the APA. Claim 8, being dependent on claim 6, is patentable over the references for the same reason.

Claims 7, and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over applicants admitted prior art (APA) of figure 1 over Vegter (U.S. Pat. No. 6,286,073). For the following reasons, the rejection is respectfully traversed.

Claims 7 and 9 depend on claim 6, and are patentable over the APA for the same reasons as claim 6 (as well as for the reasons contained therein). Vegter does not overcome the shortcomings of the APA, and thus claims 7 and 9 are patentable over the combination of Vegter and the APA. Further, the Examiner has provided no motivation outside of the application for combining Vegter with the APA. Thus, the combination is improper.

Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over applicants admitted prior art (APA) of figure 1 over DeKoning (U.S. Pat. No. 6,240,194). For the following reasons, the rejection is respectfully traversed.

Claim 10 depends, on claim 6, and is patentable over the APA for the same reasons as claim 6 (as well as for the reasons contained therein). DeKoning does not overcome the shortcomings of the APA, and thus claim 10 is patentable over the combination of DeKoning and the APA. Further, the Examiner has provided no motivation outside of the application for combining DeKoning with the APA, and thus the combination is improper.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32771US1.

Respectfully submitted,

PEARNE & GORDON, LLP

By:



Robert F. Bodi, Reg. No. 48,540

526 Superior Avenue, East
Suite 1200
Cleveland, Ohio 44114-1484
(216) 579-1700

February 5, 2003